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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,075	04/26/2001	Jens Hake	RBL0071	2627

7590 09/20/2004
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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,075

Applicant(s)

HAKE ET AL.

Examiner

Stephen M. D'Agosta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-7,9,11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 5-7, 9, 11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 2, 4, 6-7, 9, 11 and 13-21 have been considered but are moot in view of the new ground(s) of rejection.

1. The amendment overcomes examiner objections regarding the missing abstract, cross-reference to a PCT and overall format of the application.
2. New art has been added regarding the rejection of claim 21.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20, 2, 4-7, 9, 11 and 13-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan US 6,064,875 and further in view of Merchant WO9719548 and Gallant et al US 5,590,175.

As per **claim 21**, Morgan teaches a process for the real-time charge-setting of telecommunication connections between a caller staying outside of his home network in the zone of a foreign mobile phone network and a called subscriber (abstract teaches allowing calls both in and out of home area, which reads on calls to/from the home area to a caller at another location who can be either in or out of the home area as well, figures 1-4 and C10, L5 to C12, L42), comprising:

and the real-time charge-setting take place through the home network (abstract teaches using the HLR to permit calls outside home area by checking if call has been paid, which reads on the claim language

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But is silent on the building-up of the telecommunication connection between the calling subscriber and the called subscriber in home network and upon the arising of a desire on the part of the calling subscriber for a connection, sending a special telegram over the mobile network by the calling subscriber to a special network element located in the home network, the telegram containing at least the desired target number of the called subscriber and the identity of the calling subscriber.

Merchant teaches setting up a call connection between a home and non-home locations whereby the a message is sent (Internet, SMS, etc) to a service provider who makes the connection between caller and called party (respectively in home and foreign areas/zones).

Gallant teaches enhanced call completion whereby "query messages" are used to assist with the routing of the call and one skilled would use these for intra/inter-system call completion operations, and hence reads on the claim (abstract and figures 1-4, 10-13 and C4, L25 to C5, L50)

It would have been obvious to one skilled in the art at the time of the invention to modify Morgan, such that building of the connections between callers is done in the home network, to provide means for fraud monitoring/reduction.

As per **claim 2**, Morgan in view of Merchant teaches claim 21 wherein the outgoing connections are locked with the subscriber staying outside of his home network (abstract teaches prohibiting the user from making a call when outside their home network which reads on "outgoing connections are locked").

As per **claims 4, 9, 10**, Morgan in view of Merchant claim 21/2/3 **but is silent on** whereby the telegram message is drafted and sent as an SMS message.

Merchant discloses multiple known ways in which a message can be sent, including a "data message" via a computer network, a packet-switched network such as SS7 and via a non-signaling network which reads on an SMS message (as is known in the art of cellular communications) [abstract and page 1, L4-8].

It would have been obvious to one skilled in the art at the time of the invention to modify Morgan, such that the telegram message is an SMS message, to provide means for sending the data via cellular messaging service.

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As per **claims 5, 11, ~~12~~ and 13**, Morgan in view of Merchant claim 21/2/3/4 further comprising the special network element, after checking the current charge credit allocated to the data, builds up the connection between called and calling subscribers (abstract teaches if the call is paid in advance).

As per **claims 6, 14, 15, 16 and 17**, Morgan in view of Merchant claim 21/2/18/4 **but is silent on** further comprising the special network element is implemented in the form of a call back server with connection to intelligent network functions.

Merchant teaches service provider "hardware" that receives the message and dials the destination number of the called party and then bridges the call to the calling party (which reads on the claim).

It would have been obvious to one skilled in the art at the time of the invention to modify Morgan, such that a call-back service and intelligent network functions are used, to provide means for the connection to be established by first checking to see if is has been paid for (eg. intelligence) and then for an intermediate device to provide the connection after authorization.

As per **claims 7, 18, 19 and 20**, Morgan in view of Merchant claim 1/2/5/4 further comprising that the charge coverage of the connections takes place through an IN on-line charge-setting (C5, L50-60 teaches an account memory means that reads on the claim).

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta
9-15-04



WILLIAM TROST
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